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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/874,364 | 10/09/2001 | Edward M. Scheidt | STS 119 D1 | 2947 |

7590 12/28/2005
IP STRATEGIES, P.C.
1730 N LYNN STREET
SUITE 500
ARLINGTON, VA 22209

EXAMINER

DARROW, JUSTIN T

ART UNIT PAPER NUMBER

2132

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/874,364

Applicant(s)

SCHEIDT ET AL.

Examiner

Justin T. Darrow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-70 have been presented for examination. Claims 1, 2, 35, 36, and 66 have been canceled and claims 3-6, 9, 18, 25, 32-34, 37-40, 43, 52, 59, and 67-70 have been amended in an amendment filed 06/06/2001. Claims 24 and 58 have been amended in an amendment filed 02/27/2004. Claims 3-34, 37-65, and 67-70 have been examined.

Priority

2. Acknowledgment is made that the instant application is a continuation of Application No. 09/023,672, filed 02/13/1998.

Prosecution Reopened

3. Prosecution on the merits of this application is reopened on claims 67-70 considered unpatentable for the reasons indicated below:

4. Applicant is advised that the Notice of Allowance mailed 03/22/2004 is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 67-70 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 66-69 are drawn to a cryptographic key formed by the process of claim 37. Thus, claims 67-70 are drawn to information produced by a process.

Recently, the Court of Appeals for the Federal Circuit held that production of information is not covered under 35 U.S.C. § 271(g) as product to have been made by a patented process. See *Bayer AG v. Housey Pharm. Inc.*, 68 USPQ2d 1001, 1008 (Fed. Cir. 2003). Additionally, the Federal Circuit reasoned that a manufacture of 35 U.S.C. § 101 has the same scope as a product to have been made by a patented process of 35 U.S.C. § 271(g). See *id.* at 1005. Therefore, a cryptographic key as a product of information is not in the statutory class of a manufacture of 35 U.S.C. § 101. See also Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, ANNEX IV Computer-Related Nonstatutory Subject Matter, pages 50-55 at

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf>.

This rejection may not be overcome by claiming a cryptographic key incorporated into a computer readable medium. See *NTP Inc. v. Research In Motion, Ltd.*, 75 USPQ2d 1763, 1794-95 (Fed. Cir. 2005) (holding that there is no infringement under 35 U.S.C. § 271(g) by the production of email packets with messages (i.e. nonfunctional descriptive material)).

Allowable Subject Matter

7. Claims 3-34 and 37-65 are allowed.

8. The following is an examiner's statement of reasons for allowance:

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Claims 3-34; and 37-65 are drawn to a cryptographic key split combiner and a process for forming cryptographic keys, respectively. The closest prior art, Hirsch, U.S. Patent No. 5,276,738 A in view of Albert et al., U.S. Patent No. 5,627,894 A, discloses a similar key split combiner and process. Hirsch illustrates a cryptographic key split combiner and a process for combining comprising: a plurality of key split generators for generating cryptographic key splits (see column 1, lines 57-67); a key split randomizer for randomizing the cryptographic key splits to produce a cryptographic key (see column 1, lines 54-57 and lines 62-68; column 2, lines 1-7; column 3, lines 60-65; and figure 1A, items 10, 12, and 16); in which each of the key split generators includes means for generating key splits from seed data (see column 1, lines 49-54 and lines 62-64); in which the plurality of key split generators includes a random split generator for generating a random key split based on reference data (see column 2, lines 55-58); and generating a pseudorandom sequence based on reference data (see column 2, lines 23-29). Albert et. Al. specify generating a random sequence(see column 1, lines 51-67 and column 2, lines 1-2). However, they neither teach nor suggest generating a random sequence based on the reference data. This particular limitation incorporated into independent claims 3 and 37 renders claims 3-34; and 37-65, respectively, allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Takayanagi, U.S. Patent No. 5,168,371 A discloses a cryptographic key including a stream of symbols encoded on a computer readable medium.
- Park, U.S. Patent No. 5,796,826 A describes a cryptographic key including a key matrix encoded on a computer readable medium.

Telephone Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin T. Darrow whose telephone number is (571) 272-3801, and whose electronic mail address is justin.darrow@uspto.gov. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón, Jr., can be reached at (571) 272-3799.

The fax number for Formal or Official faxes to Technology Center 2100 is 571-273-8300. In order for a formal paper transmitted by fax to be entered into the application file, the paper and/or fax cover sheet must be signed by a representative for the applicant. Faxed formal papers for application file entry, such as amendments adding claims, extensions of time, and statutory disclaimers for which fees must be charged before entry, must be transmitted with an authorization to charge a deposit account to cover such fees. It is also recommended that the cover sheet for the fax of a formal paper have printed "**OFFICIAL FAX**". Formal papers

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transmitted by fax usually require three business days for entry into the application file and consideration by the examiner. Formal or Official faxes including amendments after final rejection (37 CFR 1.116) should be submitted to 571-273-8300 for expedited entry into the application file. It is further recommended that the cover sheet for the fax containing an amendment after final rejection have printed not only **"OFFICIAL FAX"** but also **"AMENDMENT AFTER FINAL"**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2100.

December 22, 2005



**JUSTIN T. DARROW
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100**